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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/576,706	05/22/2000	Burch E. Zehner	1002-171B	6333

8698            7590            05/23/2003  
STANDLEY & GILCREST LLP  
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DUBLIN, OH 43017

EXAMINER
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SZEKELY, PETER A

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 05/23/2003

2L

Please find below and/or attached an Office communication concerning this application or proceeding.

Jan 22

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/576,706	ZEHNER, BURCH E.
	Examiner Peter Szekely	Art Unit 1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 14 March 2003.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 21-40 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 08 November 2002 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>21</u> . | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 21-40 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no mention in the specification of "transferring said composite directly to an extruder such that a pelletizing step is eliminated: and extruding said composite through a die to form a final shape". "Such that a pelletizing step is eliminated" is a negative limitation requiring explicit antecedent basis. The "direct transfer" and the "final shape" are not in the specification either. This is a new matter rejection.

### ***Claim Rejections - 35 USC § 102***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 21-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Laver 5,516,472, with Prutkin 6,362,252, Motegi et al. 4,783,493 or Beshay 4,717,742 cited as teaching references.
5. Laver shows the equivalence of polyvinyl chloride, polyethylene and polypropylene in the presence of cellulosic filler in column 6, lines 48-64. Prutkin

teaches the same equivalence in claim 6. For the equivalence of polyethylene and polypropylene see also Motegi et al., claim 1, and Beshay, claim 1.

6. Claims 28-40 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Cope 5,847,016, Cope 5,951,927, or Cope 6,066,6,80, in view of Waki et al. 4,800,214 or Brandt 6,117,924.

7. Cope ('016) states in column 3, lines 49-54: "In the above-described preparation of the resin mixture, the resin is added to the wood flour in a continuous mixing machine and then extruded and pelletized in a pelletizer machine. In this first extrusion to form pellets, blowing agent is not used. Thus, the initial pelletizing extrusion does not include foaming of the polymer blend." The meaning of this quote is that the composite is directly transferred to an extruder such that there is no pelletizing step prior to extruding and the composite is extruded through a die to form a final shape, which happen to be pellets. The composition contains no blowing agent and is not foamed. There is no difference discerned from applicant's process and/or composition. The rejections are maintained.

8. Claims 28, 31, 34-36 and 39 are rejected under 35 U.S.C. 102 (b) as being anticipated by Schinzel et al. 4,168,251.

9. Schinzel et al. disclose 25-30% of wood meal with PVC in the Abstract and claim 1, molecular weights, stabilizers, lubricants and processing aids and extrusion in Example 1. Lead stearate is both a stabilizer and a lubricant. See Hawley's Condensed Chemical dictionary, 12<sup>th</sup> Edition, Van Nostrand Reinhold Company, New York, page 691, (enclosed). Applicant's claims are not novel.

***Claim Rejections - 35 USC § 103***

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. Claims 21-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laver 5,516,472, in view of Prutkin 6,362,252, Motegi et al. 4,783,493 or Beshay 4,717,742.

12. All references have been discussed previously. Since the secondary references confirm the equivalence of polyethylene and polypropylene, shown by Laver in column 6, lines 48-60, it would have been obvious to one having ordinary skill in the art, at the time the invention was made, to use the same formulations for polypropylene, which Laver uses for polyethylene.

13. Claims 28-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laver 5,516,472, in view of Cope 5,847,016, Cope 5,951,927, Cope 6,066,680 or Schinzel et al. 4,168,251, further in view of Waki et al. 4,800,214 or Brandt 6,117,924, even further in view of Prutkin 6,362,252.

14. All references have been discussed previously. Prutkin is added to reinforce the proof for the equivalence of polyethylene and polyvinyl chloride in wood flour containing compositions. See claim 6. The rejections are maintained.

***Double Patenting***

15. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

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unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

16. Claims 21-25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 11-19 of U.S. Patent No. 6,498,205. Although the conflicting claims are not identical, they are not patentably distinct from each other because the ingredients are the identical, the concentrations overlap and the process is the same.

#### ***Response to Arguments***

17. Applicant's arguments filed 3/14/03 have been fully considered but they are not persuasive. The pelletizing step takes place after the extrusion. There is no blowing agent added before the pelletizing step. See Cope ('016) from column 3, line 49, to column 4, line 16. Furthermore, it is well settled that "consisting essentially of" does not preclude the applied references' other ingredients unless applicant can establish that their presence would deleteriously affect obtaining the properties or use which applicant seeks in the sole use of the commonly required additive(s). *In re Hertz* 537 F.2d 549, 551-52, 190 USPQ 461 (CCPA 1976); *In re Janakirama-Rao* 317 F.2d 951, 137 USPQ 893 (CCPA 1963). Waki et al. and Brandt suggest particular ingredients to be used for

polyvinyl chloride/wood flour composites. Applicant's amendment contains new matter. Laver shows the equivalence of polyethylene, polypropylene and polyvinyl chloride in formulations containing wood flour in column 6, lines 48-64. The newly cited references: Prutkin 6,362,252, Beshay 4,717,742 and Motegi et al. 4,783,493, (the last one cited previously by the previous examiner), are further proof of this equivalence. All anticipation and obviousness rejections are maintained. The double patenting rejections of Paper #17 and the enablement rejection are withdrawn in light of applicant's response.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Szekely whose telephone number is (703) 308-2460. The examiner can normally be reached on 7:00 a.m.-5:30 p.m. Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Peter Szekely  
Primary Examiner  
Art Unit 1714

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P.S.

May 9, 2003